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09/851,391	05/09/2001	Yoshiaki Moriyama	041465-5111	3429

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DRINKER BIDDLE & REATH (DC)  
1500 K STREET, N.W.  
SUITE 1100  
WASHINGTON, DC 20005-1209

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/851,391

Applicant(s)

MORIYAMA ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 April 2007 has been entered.

### ***Response to Amendment***

2. The amendment filed 20 April 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: one type of the scramble system of the information signal to which the copy control information permitting only one recording of the information signal outputted from a receiving apparatus (1) in an information recording medium is given, and for permitting only one copy of the recorded information signal to another information recording medium.

3. The specification appears to support two types of the predetermined descramble systems where one type of the predetermined descrambles systems allows for one copy prior to recording, and the other type allows for one copy to be made after recording (Page 8, lines 9-19 & Page 11, line 19 – Page 12, line 3).

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

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4. Applicant's arguments with respect to claim 31-52 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

5. Claim 46 is objected to because of the following informalities: In line two change "the a forbidding" to "a forbidding." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 36, 43, 48, 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for two types of predetermined descramble systems where "one type of the scramble system of the information signal to which the copy control information permitting only one recording of the information signal outputted from a receiving apparatus (1) in an information recording medium is given, and for permitting only one copy of the recorded information signal to another information recording medium."

8. The specification appears to support two types of the predetermined descramble systems where one type of the predetermined descrambles systems allows for one copy prior to recording, and the other type allows for one copy to be made after recording (Page 8, lines 9-19 & Page 11, line 19 – Page 12, line 3).

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Claims 48 and 52 are rejection for the same rationale provided above for claim 36.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 31-33, 37-40, 44-52 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps are: Descramble system applying step applying a predetermined descramble system to the inputted information signal prior to the scramble system applying step applies the predetermined scramble system. The specification (Page 7, lines 19-25) discloses that the descramble step needs to be performed before the scrambling step is performed.

11. Claims 36, 43, 48, 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite, "one type of the scramble system of the information signal to which the copy control information permitting only one recording of the information signal outputted from a receiving apparatus (1) in an information recording medium is given, and for permitting only one copy of the recorded information signal to another information recording medium," which renders the claim indefinite because if the information signal contains copy control information permitting only one copy, how is the information signal recorded and then copied after having been recorded (implies two copies)?

For the purposes of examination the claims will be treated as having two different descramble systems when the copy control information indicates copy once.

Claims 48 and 52 are rejected for the same rationale provided above for claim 36.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 31-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto, EP 938,091. Referring to claims 31, 38, 45, 49, Hashimoto discloses an information recording system wherein data is recorded and encrypted, with copy control information, in different modes to allow for varied copy protection (Col. 7, lines 33-60 & Col. 8, lines 26-45 & Figure 5), which meets the limitation of a selected conditions setting step of setting a selected condition to eliminate copying of the information signal via an unauthorized path, the selected condition including combinations of a plurality of types of scramble systems applicable to the information signal and a plurality of types of the copy control information. When the data is received the copy control information and encryption mode indicator are read from the data header to determine the copy protection that is to be implemented (Col. 8, lines 37-46), which meets the limitation of a discrimination step of discriminating the type of the scramble system of the inputted information signal and the type of the copy control information of the inputted information signal. The copy control information and the encryption mode indicator are updated prior to the data being encrypted and stored on a recording medium (Col. 9, lines 7-60), which meets the limitation of a scramble system of applying a predetermined scramble system to the inputted information signal and producing a scrambled output when a combination of the discriminated type of the scramble system and the discriminated type of the copy control

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information coincides with that included in the selected condition, a recording step of recording the scrambled output on the recording medium. When both the copy control information and the encryption mode indicator indicate copy once, the copy control information and the encryption mode indicator are updated to copy prohibited before the data is encrypted and recorded (Col. 9, lines 34-39 & Figure 5), which meets the limitation of wherein a type of the predetermined scramble system is different from that of the scramble system of the inputted information signal, wherein a type of the predetermined scramble system is different from that of a scramble system which a reproduction apparatus applies to information signal recorded in the recording medium by the recording step, the reproduction apparatus being capable of reproducing the recording medium.

Referring to claims 32, 33, 39, 40, 47, 51, Hashimoto discloses that when both the copy control information and the encryption mode indicator indicate copy once, the copy control information and the encryption mode indicator are updated to copy prohibited before the data is encrypted and recorded (Col. 9, lines 34-39 & Figure 5), which meets the limitation of the scramble system applying step applies a scramble system different from that of the information signal recorded on a prerecorded disc to the inputted information signal when the discriminated type of the copy control information of the inputted information signal coincides with that of the inputted information signal recorded on the prerecorded disc and produces the scrambled output, wherein the copy control information permits only one copy of the information signal.

Referring to claims 34, 35, 41, 42, Hashimoto discloses that a decryptor provides decryption of the input data signals (Col. 7, lines 41-44), which meets the limitation of wherein the recording method further comprises a descramble system applying step of applying a

predetermined descramble system to the inputted information signal, wherein the scramble system applying step applies the predetermined scramble system to the inputted information signal after the predetermined descramble system is applied, the predetermined descramble system is restricted to a descramble system corresponding to a scramble system which is previously set.

Referring to claims 36, 43, 48, 52, Hashimoto discloses two different scramble/descramble modes when the copy control information indicate copy once (Figure 31 shows encryption modes of 'once' and 'proh' when the copy control information indicates copy once), which meets the limitation of the descramble system applying step applies two types of the predetermined descramble systems to two types of scramble systems of the inputted information signals respectively, one type of the scramble system of the information signal to which the copy control information permitting only one recording of the information signal outputted from a receiving apparatus (1) in an information recording medium is given, and for permitting only one copy of the recorded information signal to another information recording medium, and another type of the scramble system is a scramble system of the information signal outputted when reproduction is executed from a recording medium to which the copy control information for permitting only one copy of the information signal is given.

Referring to claims 37, 44, Hashimoto discloses that one of the copy protection modes indicated by the copy control information and the encryption mode indicator is copy prohibited (Col. 9, lines 47-60 & Figure 5), which meets the limitation of the scramble system applying step applies only one predetermined scramble system to the inputted information signal, and the only one predetermined scramble system is a scramble system which is applied to the case where



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recording information to which copy control information for forbidding copies after the information signal is copied once is given is recorded onto the recording medium.

Referring to claims 46, 50, Hashimoto discloses that the system provides for copy prohibited modes in various scenarios (Figure 5), which meets the limitation of the reproduction method further comprises the a forbidding reproducing step of forbidding reproducing the read information signal when a combination of the discriminated type of the scramble system and the discriminated type of the copy control information does not coincide with that included in a selected condition, wherein the selected condition includes combinations of a plurality of types of scramble systems applicable to the information signal and a plurality of types of the copy control information to eliminate copying of the information signal via an unauthorized path.

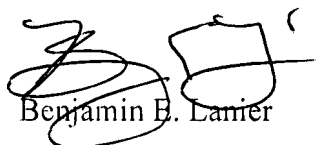
### *Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Benjamin E. Lanier